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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/702,302

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Hans Maag

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03/29/2005

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PATENT LAW DEPT. M/S A2-250
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EXAMINER

HABTE, KAHSAY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/702,302	Applicant(s) MAAG ET AL.	
	Examiner Kahsay Habte, Ph. D.	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-16 and 33-50 is/are pending in the application.
- 4a) Of the above claim(s) 44-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-13,15,16,33-43 and 47-50 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/12/04 & 12/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-3, 5-16 and 33-50 are pending in this application.

Election/Restriction

2. Applicant's election without traverse of Group I, Claims 1-3, 5-16, 33-43 and 47-50 in a paper filed on 2/22/2005 is acknowledged.

Information Disclosure Statement

3. Applicant's Information Disclosure Statement, filed on 12/20/2004 and 4/12/2004 has been acknowledged. Please refer to Applicant's copies of the 1449 submitted herewith.

Abstract

4. Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

It is recommended that applicants define variables **X**, **Y**, **Z**, **R²** and **n** in the abstract and include the use of the compounds e.g. these compounds are used for the treatment of central nervous system disorders. The definition of variables **R¹**, **R³-R⁹**, **m**, **p** and **q** is not necessary in the abstract.

Complete revision of the content of the abstract is required on a separate sheet.

Claim Objections

5. Claim 13 is objected to because of the following informalities: there is no period at the end of the claim.
6. Claim 14 is objected to because the nomenclature of the species is not consistent. Applicants have italicized the "H" part of the nomenclature in naming only some of the species e.g. in page 4, see species 19-23 and in page 5, see the last species. It is recommended that applicants be consistent in naming the species.
7. Claim 35 is objected to because the variables "R^a" and "R^b" are not included in the phrase "wherein R¹, R³, R⁴, R⁵, R⁶,and r are as defined in claim 1" as it was done for variable "r". It is recommended that the claim reads as "wherein R¹, R³, R⁴, R⁵, R⁶, ... R^a, R^b and r are as defined in claim 1".

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5-13, 15-16, 33-43 and 47-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

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a. Claim 1 and claims dependent thereon are rejected because the phrase "R³ and R⁴ together with their shared carbon may form a ring of 3 to 6 members that optionally includes a nitrogen or oxygen heteroatom" is not clear. What ring? Is it carbocyclic or heterocyclic ring? If it is heterocyclic ring, what is the nature and the number of the heteroatoms? Note that if applicants intend a heterocyclic ring, then the phrase "optionally includes a nitrogen or oxygen heteroatom" is superfluous.

b. Claim 5 is unclear in the recitation of "The compound of claim ~~43~~". It is unclear as to whether applicants intend for claim 5 to depend from claim 3 (by way of strikethrough of claim 4) or to depend from claim 43. If applicants intend for claim 5 to depend from claim 43, it is noted that claim 43 is not a compound claim, but a composition claim. If applicants intend for claim 5 to depend from claim 3, it is suggested that applicants use double brackets, e.g., ~~[[4]]~~, to delete "4" as strikethrough of the number 4 cannot be easily perceived. See the Revised Amendment Practice of 37 CFR 1.121. In the interest of advancing prosecution, claim 5 has been interpreted as depending from claim 3.

c. In claim 35, the phrase "R¹⁰as defined in claim 1" lacks antecedent basis, because there is no definition for variable "R¹⁰" back in claim 1. It is recommended that applicants delete "R¹⁰" from said phrase, since applicants have defined "R¹⁰" in claim 35.

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d. In claim 36, the phrase "R¹⁰ and t are as recited in claim 1" lacks antecedent basis. There is no definition for variables "R¹⁰" and "t" back in claim 1. Note that claim 36 depends on claim 1, but there is no definition for said variables back in claim 1. Like wise the same problem exists in claim 49, since claim 49 depends on claim 36. In regard to claims 49-50 that are dependent on claim 47, it is redundant to recite "and R¹....r and t as described in claim 41" because claim 47 recites all said variables.

Closest Prior Art

9. The closest prior art is Kume et al. US Pat. No. 4,902,335, but it fails to teach monocyclic or bicyclic rings (e.g. piperidine, quinolines, piperazine, fused piperazines, azepine, fused azepines, diazepines etc.) that are attached directly to the benzo moiety of the 1,4-benzoxazine ring. Kume et al. teach namely imidazo[1,5-1]pyridne-1,3 (2H,5H)-dione (fused imidazolidine ring) that is different from applicant's invention, since the imidazo ring contains two oxo groups at 1 and 3 positions of the imidazo[1,5-1]pyridine ring.

Objection

10. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

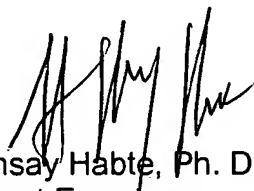
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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674, if there is no reply within 24 hours, James Wilson (Acting SPE) can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kahsay Habte, Ph. D.
Patent Examiner
Art Unit 1624

KH
March 21, 2005